REMARKS

By this amendment, Applicants amend claims 1, 10, and 20, and cancel claims

16-19, 27-31, and 42-46 without prejudice or disclaimer of the subject matter thereof.

Claims 1-4, 6, 8-15, and 20-26 are now pending in this application.

In the Office Action[1], the Examiner took the following actions:

> rejected claims 1-4, 6, 8, 9, 10-13, 15, 20-23, 25, and 26
> under 35 U.S.C. § 103(a) as being unpatentable over <u>Haber</u>
> (U.S. Re, 34,954) in view of <u>Pasieka</u> (U.S. Patent No.
> 6,587,945), <u>Falls</u> (U.S. Patent No. 6,247,149), and <u>Byrd</u>
> (U.S. Patent No. 6,081,899); and

> rejected claims 14 and 24 under 35 U.S.C. § 103(a) as being
> unpatentable over <u>Haber</u> in view of <u>Falls</u>, <u>Byrd</u>, and X.509.

Applicants respectfully traverse the above rejections. A *prima facie* case of

obviousness has not been established for at least the following reasons.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear

articulation of the reason(s) why the claimed invention would have been obvious. . . .

[R]ejections on obviousness cannot be sustained with mere conclusory statements."

M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation

omitted). "[T]he framework for the objective analysis for determining obviousness under

35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966). . . . The factual inquiries . . . [include determining the scope and content of the

prior art and] . . . [a]scertaining the differences between the claimed invention and the

prior art." M.P.E.P. § 2141(II). In rejecting a claim, "Office personnel must explain why

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

the difference(s) between the prior art and the claimed invention would have been

obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claim 1, as amended, recites a computer-implemented method for authenticating

an electronic message sent from a sender to a recipient including, among other steps,

"sending, from the authentication server, to the recipient, the electronic message

[comprising message data and an electronic mail address of the recipient] and an

electronic postmark data structure comprising the digest, the temporal stamp, the

unique value, and the digital signature to the electronic mail address, the electronic

message being sent from the authentication server as data that is separate from the

electronic postmark data structure."

The Office Action alleges that Haber "teaches sending the digest, time stamp,

unique value, and signature to the electronic address as an electronic postmark

(transmitted to the author)" and appears to imply that this constitutes sending an

electronic postmark to a recipient. *See* Office Action at page 3. This is not correct.

Haber discloses:

> In its general application as depicted in FIG. 1 of the
> drawing, the present method entails an author's preparation
> of a digital document, which may broadly comprise any
> alphanumeric, audio, or pictorial presentation, and the
> transmission of the document, preferably in a condensed
> representative form, to the TSA. The TSA time-stamps the
> document by adding digital data signifying the current time,
> applying the agency's cryptographic signature scheme to the
> document, and transmitting the resulting document, now a
> certificate of the temporal existence of the original document,
> back to the author where it is held for later use in required
> proof of such existence.

Haber, col. 2, line 65 to col. 3, line 10 (emphases added).

As set forth above, Haber discloses that an author creates a document, which a

time-stamping agency (TSA) time-stamps and then sends back to the author.

Specifically, in Haber, the author receives his or her own document back from the TSA.

Sending a "document," as in Haber, back to the author does not constitute or suggest

sending an electronic message from a sender and an electronic postmark to a recipient.

Accordingly, Haber does not teach or suggest "sending, from the authentication server,

to the recipient, the electronic message [sent by a sender and comprising message data

and an electronic mail address of the recipient] and an electronic postmark data

structure comprising the digest, the temporal stamp, the unique value, and the digital

signature to the electronic mail address, the electronic message being sent from the

authentication server as data that is separate from the electronic postmark data

structure," as recited in independent claim 1.

Byrd does not compensate for the deficiencies of Haber. In describing Figure 4,

Byrd discloses:

> The outgoing mail server 404 automatically encodes the
> message further so the resulting message that is transferred
> looks like the original 403, with a payload around the
> message containing the time stamp and the time authority's
> signature 402. The resulting message can be encrypted,
> based on the user's preferences, using the recipient's key, or
> all three (user A, user B, and the time authority) keys. User
> B 407 receives a message 408 with the date and time 409
> and the time stamp authority's certificate 410 that tells
> whether the message was tampered or not. The second
> layer 411 is the original message which has not been
> altered, only encapsulated.

Byrd, col. 3, line 61, to col. 4, line 5.

As set forth above, Byrd discloses encoding a message "with a payload around

the message containing the time stamp and the time authority's signature." Col. 3, lines

63-65. The Office Action appears to allege that message 408 constitutes Applicants' claimed "electronic postmark data structure." *See* Office Action at pages 3-4. However, as shown in Figure 4 of Byrd, message 408 includes the date and time 409, the certificate 410, **and** the encapsulated original message (i.e., second layer 411). In contrast, Applicants' claim 1 recites, in part, "sending, from the authentication server, to the recipient, the electronic message and an electronic postmark data structure comprising the digest, the temporal stamp, the unique value, and the digital signature to the electronic mail address, the electronic message being sent from the authentication server as data that is separate from the electronic postmark data structure." Accordingly, message 408 in Byrd does not constitute or suggest Applicants' claimed "electronic postmark data structure," as recited in claim 1.

The other cited references, Falls, Pasieka, and X.509, do not compensate for the deficiencies of Haber and Byrd that were discussed above. That is, the other cited references also do not teach or suggest "sending, from the authentication server, to the recipient, the electronic message and an electronic postmark data structure comprising the digest, the temporal stamp, the unique value, and the digital signature to the electronic mail address, the electronic message being sent from the authentication server as data that is separate from the electronic postmark data structure," as recited in independent claim 1.

As explained above, the elements of independent claim 1 are neither taught nor suggested by the cited references, and the Office Action has cited no factors which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Office Action has neither properly

determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Therefore, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art and a *prima facie* case of obviousness has not been established for at least the above reasons.

Independent claims 10 and 20, while of a different scope from each other and claim 1, include recitations similar to those discussed above in connection with claim 1. Accordingly, for reasons similar to those discussed above, the cited references, individually or in combination, fail to teach or suggest all of the elements of claims 10 and 20. Accordingly, claims 10 and 20 are not obvious in view of the cited references for at least the reasons discussed above and the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Claims 2-4, 6, 8, 9, 11-15, and 21-26 depend from one of independent claims 1, 10, and 20. Accordingly, claims 2-4, 6, 8, 9, 11-15, and 21-26 are not obvious in view of the cited references at least due to their dependence. Therefore, the Examiner should also withdraw the rejection of these claims under 35 U.S.C. § 103(a).
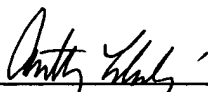
CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 15, 2009   By:_____
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